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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,254	12/06/2001	Masajiro Inoue	SIW-025	5647

959 7590 01/24/2005  
LAHIVE & COCKFIELD, LLP.  
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BOSTON, MA 02109

EXAMINER

ORTIZ, ANGELA Y

ART UNIT PAPER NUMBER

1732

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/010,254

Applicant(s)

INOUE ET AL.

Examiner

Angela Ortiz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/29/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The drawings were received on 21 June 2004. These drawings are accepted.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8, 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al., USP 6,649,097 in view of Engelhardt, USP 3,619,458.

The cited primary reference substantially teaches the basic claimed method of molding a gasket or seal onto a carbon plate or separator, the steps comprising providing a separator plate, forming a hole in the plate, positioning the plate within a mold cavity between an upper mold and a lower mold such that the through hole is between an upper and lower grooved surface of the molds, and injecting seal material such that the material fills the grooves and the through hole to form a contoured seal. The mold is provided with a runner and multiple gates, upper grooved surfaces on the upper mold and lower grooved surfaces on the lower mold, and can include support means within one grooved surface when molding a seal on one side, and an injection source for the seal material. The porous carbon plate being molded on can comprise a separator plate, and include a through hole or multiple holes. Note that a seal bridge is readable on the upper and lower grooves connected by the through holes in the plate.

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See col. 4, lines 20-25, 48-60; col. 5, lines 50-65; col. 6, lines 1-5, 12-30, 40-50, 55-65; col. 7, lines 1-20 and col. 8, lines 10-20, 53-65.

The cited primary reference does not set forth the seal material separately supplied to the gates, or the gate connected to a portion not on the sealing surface.

The added reference sets forth the molding of a gasket using gates that are separately supplied with gasket forming material, wherein the gate rests on a portion not on the sealing surface of the gasket. See figure 3, col. 2, lines 20-40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide separate supply sources and use a gate not on a sealing surface as shown in the added reference, when performing the process set forth in the primary reference, for molding the gasket using equivalent alternative means and for forming a seal wherein the gate sprue does not interfere with sealing functions of the gasket.

With respect to claim 3, note that the primary reference sets forth the gate on the sealing surface of the seal.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/000,460. Although the conflicting claims are not identical, they are not patentably distinct from each other because both set forth a method of forming a seal-integrated separator for a fuel cell comprising injecting a seal material into a mold of desired configuration, and forming a seal around a separator plate wherein the seal is formed with a grooved surface and a connecting bridge.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Allowable Subject Matter***

Claim 9 is allowed.

#### ***Response to Arguments***

Applicant's arguments filed 21 June 2004 and 03 November 2004 have been fully considered but they are not persuasive.

Note that the 102 rejection is not applied in this office action and therefore arguments regarding the 102 rejection are deemed moot.

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Applicant argues that the Engelhardt reference fails to teach the inner seal and the outer seal disposed on the same surface and side by side as the currently amended claims recite.

Applicant is directed to figures 3 and 4, wherein dual seals on the same side are depicted. Regarding figure 4, the reference teaches that the two ribs or seals are parallel to each other and are connected to the support by means of a base. While this shows a seal bridge, note that the combination of the prior art references teach allowing the material to flow through a through hole, and has applicability to fuel cell stacks.

Note that the applicant has not filed a terminal disclaimer or contested the double patenting rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Ortiz whose telephone number is 571-272-1206. The examiner can normally be reached on Monday-Thursday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaiani can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Angela Ortiz  
Primary Examiner  
Art Unit 1732

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